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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,666	02/11/2004	Tushar Patel	101896-0233	3475

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NUTTER MCCLENNEN & FISH LLP  
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EXAMINER
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PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

NOTIFICATION DATE	DELIVERY MODE
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11/23/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@nutter.com

## Office Action Summary

Application No.

10/776,666

Applicant(s)

PATEL ET AL.

Examiner

Brian E. Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-13,15-26,28,29,31-44,46-54 and 86-93 is/are pending in the application.
- 4a) Of the above claim(s) 25,29,32,39-44,47 and 49-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,11,12,15-24,26,28,31,33,34,36,37,46,48 and 86-93 is/are rejected.
- 7) ☒ Claim(s) 9,10,13,35 and 38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/12/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's AF submission filed on 7/24/07 has been entered.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 91,93 are rejected under 35 U.S.C. 102(b) as being anticipated by Ulrich (DE 4201043). Fig. 6 shows a guide device for use with a spinal fixation plate. The guide device includes first **22'** and second **22''** arms slidably movable with respect to one another. It can also be seen the arms each include a guide member **21** coupled to the distal end of the arms and have opposed cutout portions in the opposed sidewalls at the distal ends of the guide members. It can be construed since the arms and guide

members are positioned adjacent one another the cutout portions, walls and pathways can be interpreted to "oppose" one another. Fig. 5 shows that the cutout portions are adapted to provide visualization of the positioning device that is coupled to the spinal fixation plate.

Claims 86-90 are rejected under 35 U.S.C. 102(b) as being anticipated by Santangelo (5067477). Fig. 1 shows a guide device with first **14** and second **16** members slidably movable with respect to one another and adapted to be positioned on a spinal plate. It can be seen that there are a plurality of opposing tabs **24** that are substantially C-shaped and is adapted to match the contour of the perimeter of a spinal plate. The guide members also include first and second pathways in a direction perpendicular to the axis of the guide members that extend between the tabs from a proximal to distal end of the tabs and would allow a tool to be inserted there between. It can also be construed that there are cutout portions formed in the guide members that provide a holder for the tabs which would retain the plate but allows for visualization of the plate between the guide members.

Claims 1,3,15-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Phillips et al. (7147599). Fig. 1 shows a guide device with an elongate curved support member **12** that is capable of matching the contour of the spinal column. The guide device also includes first and second arms (**18,20**) each having a proximal end transversely coupled to the elongate support member and are slidably movable along the support member to allow a distance between the first and second arms to be adjusted. It can also be seen at the distal end of each arm is a guide member with a

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pathway formed therein. Regarding claims 16,17, the arms are mated with a proximal portion of the guide members and Fig. 5 shows that the distal portion of each arm can extend at an angle with respect to the proximal portion. With respect to claims 18,19, the guide members have a shape that is adapted to match the contour of a spinal fixation plate and have opposed tabs extending distally into the pathway and adapted to engage the spinal plate. Regarding claim 22, Fig. 2 shows the first arm can be fixedly mated and the second arm is slidably mated to the support member. With respect to claim 23, the guide device has an adjustment mechanism formed as part of housing 22 at the proximal end of the second arm to allow movement along the support member.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. '599. Phillips is explained supra. However, Phillips does not explicitly disclose the adjustment mechanism comprises a spring-lock mechanism to move between different locked positions. Spring-lock mechanisms are well known in the art. It would have been obvious to one of ordinary skill in the art to substitute a spring-lock mechanism with the housing of Phillips such that it ensures that when the arm is positioned at the desired

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location the surgeon does not have to worry it will slip out and move during surgical use.

Such a modification only involves routine skill in the art.

Claims 1,3-8,11,12,15-23,26,28,31,33,34,36,37,46,48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coates et al. (5423826) in view of Phillips et al. '599. Coates discloses (Fig. 17) a guide device for use with a spinal fixation plate with the device having two movable arms **151,152** and first and second guide members **157** coupled at the distal end of the arms. There is an elongate support member **155** extending in a direction transverse to the arms and is adapted to slidably mate with the arms. Additionally, the arms have a distal portion that is at an angle to the proximal portion (Figure 20). Each guide member (157) comprises a housing with opposed first and second pathways (Figure 16) where the housing or guide member contains a lumen sleeve (180) which has a rounded tip extends through the barrel into the rounded recess of the accompanying plate. Each pathway in the guide is in communication with each other via a cut out at a distal portion formed in the housing between the first and second pathways (Figure 16) where the cut out portion extends from the housing where the pathways (158) are in communication through the body of the guide. It can be seen there are opposed cutout portions between hooks **161** or tabs that are C-shaped and allow communication between the two pathways in the guide member and this space is adapted to seat a spinal plate. However, Coates et al. fail to disclose the elongate member is curved. Phillips et al. teach (Figs. 1,2) a surgical instrument with adjustable arms used with a curved elongate support member that are capable of being locked (abstract). Phillips et al. teaches that a curved support structure would allow deeper

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access to the surgical site, col. 4, lines 61-64. It would have been obvious to one of ordinary skill in the art to incorporate the curved support member as taught by Phillips et al. with the arms and guide members of Coates et al. such that it provides the surgeon with better or deeper access into the surgical site to implant the plate.

Claim 92 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich DE (4201043). Ulrich is explained supra. However, Ulrich does not disclose having the cutout portions extend from the proximal end to a position near the distal end. It would have been obvious to one of ordinary skill in the art to modify the length and location of the cutout in the guide of Ulrich since such a modification only involves routine skill in the art and would not effect the function of the apparatus.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1,26,86,91 have been considered but are moot in view of the new ground(s) of rejection. The Examiner notes that the elongate member in Coates' device coupled to the arms is located at a proximal end of the device because all of the arm length extending from the elongate member downward can be considered distal to the elongate member and anything above the elongate member is at a proximal end. Thus, Applicant's argument that the elongate member is not coupled at a proximal end is mistaken since proximal and distal are relative terms.

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***Allowable Subject Matter***

Claims 9,10,13,35,38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Friday from 8:30am to 5pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

**BRIAN E. PELLEGRINO**  
**PRIMARY EXAMINER**

